Remarks/Arguments

Claims 1 and 15 have been amended by deleting the word "the" and replacing it with the word "an". This amendment was made for clarification purposes only and does not limit the scope of the claims in any way.

Claims 27-48 have been cancelled in response to a Restriction Requirement, which the Examiner imposed. These claims are cancelled without prejudice.

Response to Restriction Requirement

The Examiner has required that the claims be restricted to one of the following groups:

I. Claims 1-15, drawn to a method for isolating anticoagulant heparin or anticoagulant heparan sulfate;

II. Claims 16-21, drawn to an affinity matrix;

III. Claims 22-26, drawn to a method of preparing an affinity matrix;

IV. Claims 27-36, drawn to a method of preparing FGF7 protein in bacteria;

V. Claims 37-48, drawn to a method of neutralizing anticoagulation catalyzed by heparin, a heparin mimic, or a heparin derivative.

Applicants elect, with traverse, to prosecute the Group I claims, i.e., claims 1-15. For the reasons described below, Applicants believe that restriction of Groups I-III is improper and respectfully request that Groups I-III be examined in this application. Applicants have cancelled claims 27-48, i.e., Groups IV and V, without prejudice.

The Group I claims are directed to a method for isolating anticoagulant heparin or anticoagulant heparan sulfate by utilizing an affinity matrix. The affinity matrix of the Group I claims comprises fibroblast growth factor.

The Group II claims are directed to an affinity matrix for isolating anticoagulant heparin or anticoagulant heparan sulfate. The affinity matrix of the Group II claims comprises fibroblast growth factor. It is the same affinity matrix referred to in Group I and it is used for the same process as is claimed in Group I.

The Group III claims are directed to a method of preparing the affinity matrix referred to in Groups I and II. To summarize, Groups I, II, and III are directed to a method of using a product, the product itself, and a method of making the product, respectively. The product, i.e., the affinity matrix comprising fibroblast growth factor, is common to Groups I, II, and III.

The Examiner has improperly characterized Groups I and II and Groups I and III as being directed to independent, unrelated inventions. The Examiner stated that inventions I and II and inventions I and III are unrelated for the following reason:

> Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the different inventions have different function and different effects. (Emphasis added).

This is form paragraph 8.20.02, which is used for restricting unrelated inventions. The Examiner references MPEP § 806.04 and MPEP § 808.01 as his basis for restricting Groups I and II and Groups I and III. These provisions of the MPEP concern unrelated, independent inventions. Applicants respectfully traverse.

Groups I, II, and III are not independent inventions. MPEP § 806.04 gives the following criteria for determining if inventions are independent:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects. An example given in this section is an article of apparel such as a shoe and a locomotive bearing. Another example is a process of painting a house and a process of boring a well.

Groups I and II and Groups I and III are not two different combinations, not disclosed as capable of use together. Quite the opposite, they disclosed throughout the specification as being used together. The Examiner seems to think that the inventions have different function and effects simply because one is a method of using a product, one is a product, and one is a method of making the product. This viewpoint cannot be correct, in light of the vast number of patents that are issued that contain claims to both a product and a method. The methods and products of Groups I, II, and III share the unifying feature of an affinity matrix comprising a fibroblast growth factor and the share function, and effect, of isolating anticoagulant heparin or anticoagulant heparan sulfate. The features of Groups I, II, and III are clearly not as disparate as a shoe and a locomotive bearing or a process of painting a house and a process of boring a well.

(B) Where two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. An example is a specific process of molding and a molding apparatus that cannot be used to practice the specific process.

Contrarily, the affinity matrix of the present claims is specifically disclosed as being used to practice the specific process of isolating anticoagulant heparin or anticoagulant heparan sulfate.

The Examiner Note accompanying form paragraph 8.20.02 makes is clear that the assertion that Groups I/II and Groups I/III are unrelated is incorrect:

> This form paragraph is to be used only when claims are presented to unrelated invention, e.g., a necktie and a locomotive bearing.

Certainly Groups I, II, and III are not unrelated in the same sense as a necktie and a locomotive bearing; they each concern an affinity matrix for isolating anticoagulant heparin or anticoagulant heparan sulfate, wherein the affinity matrix comprises fibroblast growth factor.

Because Groups I and II and Groups I and III are not directed to independent, unrelated inventions, Applicants respectfully request that the Restriction of these groups be withdrawn and that Groups I, II, and III be examined in a common application.

Inventions II and III were improperly restricted. The Examiner correctly recognized that Groups II and III are directed to a process of making and the product made. The Examiner stated the following as his reason the inventions are distinct:

> The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process.

The Examiner alleges that the process as claimed can be used to make other and materially different products, such as a polypeptide affinity matrix. The Examiner incorrectly concluded that the Groups II and III should be restricted because they are distinct according to MPEP § 806.05(f).

Applicants neither admit nor deny that Groups II and III are directed to distinct inventions because simply showing that related inventions are distinct according MPEP 806.05 is not sufficient, on its own, to maintain a restriction.

As demonstrated above and as admitted by the Examiner, Groups II and III are related as a process of making and product made. MPEP § 808.02 requires that, where related inventions are shown to be distinct under the criteria of MPEP § 806.05(c)-§ 806.05(i), the Examiner, must show one of the following by appropriate explanation for insisting upon restriction:

(A) Separate classification. Groups II and III are not in separate classifications; they are both in class 530, subclass 350+.

(B) A separate status in the art when they are classifiable together. This may be shown by citing patent evidence of such a separate status or by showing a separate field of search. The Examiner has shown neither.

(C) A different field of search. The Examiner has not explained why a different field of search would be required for Groups II and III. Both groups concern an affinity matrix for isolating anticoagulant heparin or anticoagulant heparan sulfate, wherein the affinity matrix comprises fibroblast growth factor.

MPEP § 808.02 states that when the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. Applicants therefore respectfully request that the Examiner follow the guidance of the MPEP and allow Groups II and III to be prosecuted with Group I in this application.

* * *

No fees are believed to be due in connection with the filing of this Amendment and Response, however should be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Deposit Account No. 01-2508/12740.0232.NPUS01.

The Examiner is invited to contact the undersigned patent agent with any questions or comments related to the enclosed materials.

Respectfully submitted,

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